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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 1033-T00537	
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		First Named Inventor Hisao M. Chang	
		Art Unit 2645	Examiner ESCALANTE, Ovidio
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/93) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>42,146</u>		Signature <u>Adam D. Sheehan</u> Typed or printed name <u>(512) 327-6515</u> Telephone number <u>10/21/05</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE CENTRAL FAX CENTER**

Applicants: Hisao M. Chang

Title: VOICEXML AND RULE ENGINE BASED SWITCHBOARD FOR INTERACTIVE  
VOICE RESPONSE (IVR) SERVICES

App. No.: 10/672,292

Filed: September 26, 2003

Examiner: ESCALANTE, Ovidio.

Group Art Unit: 2645

Customer No.: 34456

Confirmation No.: 8322

Atty. Dkt. No.: 1033-T000537

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**REMARKS IN SUPPORT OF  
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed July 28, 2005 (hereinafter, "the Final Action") and further pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicants respectfully request review and reconsideration of the Final Action in view of the following issues.

**Claims 1-8, 10-12, 15-22, 26, 28, 34, and 35 are allowable**

Claims 1-8, 10-12, 15-22, 26, 28, 34 and 35 were rejected under 35 U.S.C. § 103(a) over Dhir (US Patent No. 6,553,113) in view of Ball, et al. (US Patent No. 6,600,736). Claim 1 recites "a voice converted data module having an input to receive an incoming call, the voice converted data module responsive to an interactive voice response unit or an internet based communication device." As admitted by the Final Action at page 3, Dhir does not disclose or suggest this element.

The Final Action asserts that this element is disclosed by the combination of Dhir and Ball. However, "[i]t is improper to combine references where the references teach away from

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their combination.” (MPEP § 2145). In this case, Dhir and Ball teach away from combining the references. For example, Dhir states

Some toll free sites are so-called “virtual call centers,” whereby calls are routed to agents at call centers at different geographic locations. These systems have significant drawbacks in their ability to properly route calls. Often a customer's particular needs are not fully ascertained until after a call has been routed to a call site. It is not uncommon that a call will have to be rerouted to a different site because a qualified agent does not exist or is occupied at that site. In the example given above, the customer seeking a limit increase may be routed to a first site that has no available agents with that skill set. The result is that the call routing system must “pull back” the call to reroute it to a second site. This ties up system resources (e.g., ports at a peripheral device at the first call site) and often results in customer dissatisfaction. *This problem, referred to as “site interflow,” is a significant drawback in conventional systems.*

(Dhir, col. 1, line 54 – col. 2, line 2 (emphasis added)). Further, “[i]n short, conventional systems' inability to route calls to the best agent on the ‘first pass’ results in two significant drawbacks. First, system resources are used suboptimally, resulting in significant costs for call routing systems that may have to handle thousands of calls per hour. Second, customer satisfaction is not maximized, resulting in lost accounts and sales. *In a modern economy where service is the hallmark of successful enterprises, this is a significant disadvantage.*” (Dhir, col. 2, lines 18-27). Thus, according to Dhir, routing a call from one call site to another is a “significant disadvantage.” However, Ball in direct contrast to Dhir teaches a system for routing a call from one site to another. For example, Ball states

In accordance with the present invention, a transfer capability is provided to enable an end user who is connected via his telephone set to a first web-based IVR service to transfer to a second separately configured web-based IVR service without placing an additional telephone call, and wherein information associated with the end user's transaction with the first service is transferred to the second service. Specifically, while interacting in an IVR session in a first service through a telephone/IP server, *the end user may be audibly presented with the ability to transfer to a specific second service.* That second service may be totally distinct from the first service, or may be related to the first service, such as a different department of that first service provider, *but which second service is configured with a service logic on a web server separate from the service logic providing the first service.*

(Ball, col. 4, line 64 – col. 5, line 11 (emphasis added)). Thus, Ball teaches a system that, according to Dhir, would result in a “significant disadvantage.” Accordingly, Dhir and Ball teach away from their combination, and such combination cannot be used as the basis for an

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obviousness rejection. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

In addition, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP § 2143). Combining Ball with Dhir would result in the Dhir system being unsatisfactory for its intended purpose. For example, as explained above, the purpose of Dhir is to reduce or eliminate the routing of a call from one call site to another. To accomplish this purpose, Dhir discloses a call routing system wherein the system receives routing requests from an interexchange carrier. (Dhir, col. 4, lines 55-56). The Dhir system returns a return route address to the interexchange carrier. The route address is used to route the call to a *single* interactive voice response (IVR) unit. (Dhir, col. 5, lines 56-65). Calls may be routed by the call routing system to a second IVR instead of the first IVR if the first IVR is busy. (Dhir, col. 9, lines 15-58). Thus, *calls are routed only once*. Calls are not routed from the first IVR to the second IVR, because this would be against the purpose of Dhir to reduce the number of times a call is routed. Further, as explained above, Ball discloses a system for routing a call from one IVR web server to another. Accordingly, combining Dhir and Ball would lead to an *increase* in the number of times the Dhir system would route a call to a second site, which is against the express purpose of Dhir. Thus, modifying Dhir to include the Ball system would render Dhir unsatisfactory for its intended purpose of reducing the number of times a call is routed.

Accordingly, Ball teaches away from the intended purpose of Dhir, and the combination of the references cannot be used as the basis for an obviousness rejection. Therefore, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

With respect to claims 2-8, 10-12, 15-22, 26, 28, 34 and 35, these claims depend from claim 1. Accordingly, these claims are allowable over Dhir and Ball, at least by virtue of their dependency on claim 1. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

**Claims 29 and 30 are allowable**

Claims 29 and 30 were rejected under 35 U.S.C. § 102(e) over Ball, et al., in view of Margolis (US Patent Pub 2003/0235287). Applicant respectfully points out that it is improper to

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combine references for a rejection under § 102. MPEP § 2131.01.<sup>1</sup> Accordingly, Applicant requests that the rejection be withdrawn.

In addition, the Final Action at page 7 states that Margolis teaches the element “the email including a targeted communication message relating to the subject matter of the call” of claim 29 and the element “wherein the email includes information responsive to the customer request” of claim 30. Applicant respectfully traverses these assertions. According to the paragraph of Margolis cited by the Final Action:

Further, these messages can be in any form or shape such as an e-mail, a pushed web page, an instant message, a VoIP message, an SMS message, a pop-up window, etc., and may include, but are not limited to, a message notifying the estimated time until the callback (which may pop up on the display device associated with the caller device 10), a web form providing a menu of options for the caller's selection (e.g., cancel call, need technical support, etc.), an e-mail or web page providing advertisements that may be caller-specific, etc. Any information which may be helpful to the current caller is provided to the caller in these IP-based messages with or without multi-media presentation, and such information including the caller's messaging preferences can be stored in the database 90.

(Margolis, p. 3, [0031]). Thus Margolis teaches sending an email with caller-specific advertisements, options regarding how to handle a callback, and information related to the callback. There is no disclosure or suggestion in Margolis that the email includes a targeted communication message relating to the subject matter of the call or that it includes information responsive to the caller's request. Accordingly, even if Margolis and Ball could be combined, the combined references would fail to disclose each and every element of claims 29 and 30. Therefore, Applicant requests that the rejection be withdrawn.

**Claims 9, 23-25, 27, 36 and 37 are allowable**

Claims 9, 23-25, 27, 36 and 37 were rejected under 35 U.S.C. § 103(a) over Dhir in view of Ball, et al., in further view of Margolis. As explained above, there is no motivation to combine Dhir and Ball, because the references teach away from the combination. Further, as noted above, Dhir teaches away from the disadvantages of “virtual call centers” and indicates

<sup>1</sup> Although a second reference may be used in a §102 reference to show inherency, define a term, or prove that the primary reference shows an enabling disclosure (MPEP §2131.01), the Final Action does not use either cited reference in any of these ways.

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that the Dhir system is a favorable alternative to such virtual call centers. However, against the teachings of Dhir, Margolis states that

the present invention provides a method and system for processing a call when a call recipient is unavailable by using an IP (Internet Protocol)-based user-interactive approach. The method *includes queuing the call in a queue associated with a call center*, obtaining a messaging preference of the caller (the messaging preferences including caller presence and availability relating to the call), disconnecting the call, generating at least one IP-based message for the caller according to the caller's messaging preference, and transmitting the at least one IP-based message to the caller over an IP network, so as to begin a virtual interaction between the caller and the call center after the call is disconnected.


(Margolis, p.1, [0011]). Thus, the Margolis system is specifically located in the call centers that are identified in Dhir as disadvantageous. Therefore, there is no motivation to combine the Dhir, Ball, and Margolis references, because those references teach away from their combination. Accordingly, Applicant respectfully submits that the rejection under §103(a) is improper and requests that the rejection be withdrawn.

**Conclusion**

As discussed above, the Final Action fails to establish that the cited references and the proper combinations thereof disclose or suggest the specific combinations of elements recited by independent claims 1 and 29. The Final Action therefore fails to establish that the cited references disclose or suggest each and every element of claims 2-24, 27,28 and 30-37. Accordingly, the pending claims are allowable over the cited references and the Applicants therefore request withdrawal of all pending rejections.

Respectfully submitted,

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Date

  
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